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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,318	01/30/2002	Randolph Fowler Totten	99997.024378	7425
21967 7590 02/25/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
OYEBISI, OJO O				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/058,318

**Applicant(s)**

TOTTEN, RANDOLPH FOWLER

**Examiner**

OJO O. OYEBISI

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4, 7, 8, 11, 12 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-4, 7-8, 11-12, and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/31/08 has been entered. In the RCE filed on 01/31/08, the following have occurred: claims 3-4, and 17 have been amended, and claims 3-4, 7-8, 11-12, and 17-19 are pending.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 3-4, 7-8, 11-12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman et al (Freedman hereinafter, US PAT: 6,249,775) in view of Han, Jun (1996, July). To securitize or not to securitize? The future of commercial real estate debt markets. *Real Estate Finance*, 13(2), 71. Retrieved October 29, 2007, from ABI/INFORM Global database. (Document ID: 10054405).

**Re claims 3, 4.** Freeman further discloses a method for compensating financial asset service providers comprising: identifying a service provider who is responsible for at least collection of a plurality of payments from a debtor to a creditor in connection with a financial account related to at least one loan and for making a plurality of payments to the creditor (i.e., third party servicers, see fig.1 element 28, also see col.5 lines 43-60). However, Freeman does not explicitly disclose determining a financial asset services value to be paid to the service provider as a percentage of the principal and interest paid in connection with the financial account. However, Han discloses determining a financial asset services value to be paid to the service provider as a percentage of the principal and interest paid in connection with the financial account (i.e., ongoing fees, see page 4, third paragraph). Thus it would have been obvious to one of ordinary skill in the art to incorporate the master servicing fee taught by Han into Freeman in order to appropriately value financial asset services.

**Re claim 7.** Freedman further discloses the method for valuing financial asset services wherein said financial asset is a mortgage loan (see fig.1 elements 12 and 20)

**Re claim 8.** Freedman further discloses the method for compensating a financial asset

service provider as claimed in claim 4 wherein said financial asset is a mortgage loan (see fig.1 elements 12 and 20).

**Re claims 11-12.** Freedman further discloses the method for compensating service providers wherein said financial asset is a credit card account (freeman discloses closed end loan portfolio and loan portfolio in general (see the abstract), which certainly encompasses credit card account, since a credit card account is a form of loan portfolio).

**Re claims 17, 18-19.** Freedman further discloses a method for structuring a financial asset service agreement except for wherein fees collected in servicing a financial asset related to at least one loan are based upon a percentage of both the principal and the interest paid in connection with the financial asset. However, Han discloses fees collected in servicing a financial asset related to at least one loan are based upon a percentage of both the principal and the interest paid in connection with the financial asset (i.e., ongoing fees, see page 4, third paragraph). Thus it would have been obvious to one of ordinary skill in the art to incorporate the master servicing fee taught by Han into Freeman in order to appropriately value financial asset services.

### ***Response to Arguments***

3. Applicant's arguments filed 01/31/08 have been fully considered but they are not persuasive. The applicant argues in substance that neither Freedman nor Han discloses compensating the service fee with a percentage of the principal paid. The

examiner concurs that the primary reference, Freedman, does not explicitly disclose compensating the service fee with a percentage of the principal paid. However, the secondary reference, Han, compensates for the incomplete teaching of Freeman by explicitly teaching " compensating the service fee with a percentage of the principal paid," (i.e., After a CMBS transaction is completed, it needs to be serviced by a master servicer with an annual fee of 3 to 7 basis points of outstanding principal, see pg 4 of Han). The examiner contends that a basis point is a unit of measure used in finance to describe the percentage change in the value or rate of a financial instrument. Thus a servicing fee of 3 to 7 basis points of outstanding principal, as taught by Han supra, simply means a servicing fee of 0.03% to 0.07% of the outstanding principal.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

O.O

**Application Number****Application/Control No.**

10/058,318

**Applicant(s)/Patent under  
Reexamination**TOTTEN, RANDOLPH  
FOWLER**Examiner**

OJO O. OYEBISI

**Art Unit**

3696